

PATENT APPLICATION

217C

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

MAIL STOP PETITION

Kazunori ANAZAWA et al.

Group Art Unit: 1753

Application No.: 10/600,352

Examiner: R. McDonald

Filed: June 23, 2003

Docket No.: 116316

For: MANUFACTURING APPARATUS AND METHOD FOR CARBON NANOTUBE

PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. §1.181(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The undersigned has received a Notice of Abandonment dated March 28, 2006, holding the above-captioned patent application abandoned for failure to file corrected drawings as required by the Notice of Allowability dated November 23, 2006. However, no drawings were required because the drawing requirement in the Notice of Allowability was in error.

The Notice of Allowability indicated that corrected drawings must be submitted including the changes required by the Office Action mailed May 2, 2005. However, no drawings were submitted in the response to the Office Action because the objection to the drawings was obviated by the July 11, 2005 Amendment, which amended the specification rather than the drawings. Further, the August 2, 2005 Final Rejection indicated on page 3 that the drawing objection presented in the May 2, 2005 Office Action was withdrawn in light of the July 11, 2005 Amendment. The Office Action Summary of August 2, 2005 Final Rejection further indicated that the drawings filed June 23, 2003 were accepted by the Examiner. Thus, no corrected drawings are needed and the indication in the Notice of Allowability is clearly in error. Accordingly, in accordance with MPEP §711.03(c), it is respectfully requested that the Notice of Abandonment be withdrawn.

Copies of the May 2, 2005 Office Action, July 11, 2005 Amendment including the date-stamped filing receipt, and the August 2, 2005 Office Action are attached.

It is respectfully submitted that no Petition fee is due. However, please debit Deposit Account No. 15-0461 as needed in order to ensure that the Notice of Abandonment is withdrawn. Please telephone the undersigned if any questions arise in connection with this matter.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Randi B. Isaacs
Registration No. 56,046

JAO:RBI/jfb

Attachments:

May 2, 2005 Office Action
July 11, 2005 Amendment
July 11, 2005 Date-Stamped Filing Receipt
August 2, 2005 Office Action

Date: April 5, 2006

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>



UNITED STATES PATENT AND TRADEMARK OFFICE



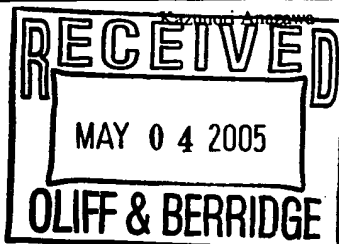
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/600,352 06/23/2003

25944 7590 05/02/2005

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320



116316

7092

EXAMINER

VERSTEEG, STEVEN H

ART UNIT

PAPER NUMBER

1753

DATE MAILED: 05/02/2005

REJECTION

Please find below and/or attached an Office communication concerning this application or proceeding.

DUE DATE

AUG - 2 2005

DOCKETED
By hmm on 5/4 20 05
and
By Jmm on 5/4 20 05
Oliff & Berridge

Office Action Summary

Application No.

10/600,352

Applicant(s)

ANAZAWA ET AL

Examiner

Steven H VerSteeg

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-33 is/are allowed.
- 6) ☒ Claim(s) 1,5-13 and 15 is/are rejected.
- 7) ☒ Claim(s) 2-4, 14 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/23/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because the abstract is greater than 150 words long. Correction is required. See MPEP § 608.01(b).
3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

4. The drawings are objected to because [0104] mentions Figures 32-a, 32-b, 31-a, and 31-b, but those figures are not present. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief

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description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 8 and 14 are objected to because of the following informalities: "is" should be "are" in claim 8 at line 2; and "are" should be "is" in claim 14 at line 3. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 15 uses the phrase "gas type" in line 3. The word "type" renders the claim indefinite.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1 and 5-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 7-15 of copending Application No. 10/656,267. Although the conflicting claims are not identical, they are not patentably distinct from each other because the conflicting claims are fully claimed in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claim 1 of the instant application differs from claim 2 of the copending application in that claim 2 additionally requires a thermal shield wall between the magnets and the plasma generation area. However, the thermal shield wall has a cooling unit. The cooling unit, because it is next to the magnets, would obviously cool the magnets. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of the copending application to utilize the cooling unit of the thermal shield wall as a magnet cooling unit because it is next to the magnets.

12. Claims 7-15 of the copending application contain all of the limitations of claims 5-13 of the instant application respectively. The claims wording is essentially identical and thus, no further discussion is necessary.

Allowable Subject Matter

13. Claims 17-33 are allowed.

14. Claim 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15. Claims 8 and 14 would be allowable if written to overcome the claim objection presented above.

16. Claims 1 and 5-13 would be allowable if a terminal disclaimer is filed to overcome the rejection(s) under double patenting, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

17. Claims 2-4 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. The following is a statement of reasons for the indication of allowable subject matter: it is neither anticipated nor obvious over the prior art of record to have an apparatus for manufacturing a carbon nanotube as claimed by Applicant in claim 1 or a method of manufacturing a carbon nanotube as claimed by applicant in claim 17.

19. ***Effects of high magnetic field on the morphology of carbon nanotubes and selective synthesis of fullerenes*** by Yokomichi et al. (Yokomichi) discloses making carbon nanotubes, but does not utilize any cooling of the magnet unit. JP 8-48510 (JP '510) discloses an apparatus and method for making carbon nanotubes, but there is no cooling of the magnet. In fact, based upon Figure 1, it appears that adding some cooling mechanism to the magnet would require a

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significant change in construction. It is only possible through hindsight to cool the magnets of Yokomichi and JP '510.

General Information

For general status inquiries on applications not having received a first action on the merits, please contact the Technology Center 1700 receptionist at (571) 272-1700.

For inquiries involving Recovery of lost papers & cases, sending out missing papers, resetting shortened statutory periods, or for restarting the shortened statutory period for response, please contact Denis Boyd at (571) 272-0992.

For general inquiries such as fees, hours of operation, and employee location, please contact the Technology Center 1700 receptionist at (571) 272-1300.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven H VerSteeg whose telephone number is (571) 272-1348. The examiner can normally be reached on Mon - Thurs (6:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven H VerSteeg
Primary Examiner
Art Unit 1753

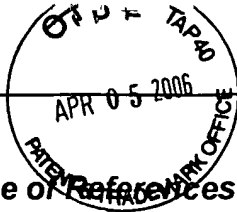
shv
February 7, 2005

Sheet 1 of 1

Form PTO-1449 (REV. 8-83)		US Dept. of Commerce PATENT & TRADEMARK OFFICE		ATTY DOCKET NO. 116316		APPLICATION NO. New U.S. Patent Application <u>19/600,352</u>	
INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary)				APPLICANTS Kazunori ANAZAWA et al.			
				FILING DATE June 23, 2003			
U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	
<u>SHV</u>	<u>1</u>	US 2002/0179428 A1	12/05/2002	Anazawa et al.	<u>204</u>	<u>172</u>	
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)							
<u>SHV</u>	<u>2</u>	Anazawa et al., High-purity carbon nanotubes synthesis method by an arc discharging in magnetic field", Applied Physics Letters, Vol. 81, No. 4, pp. 739-741, 2002					
EXAMINER <u>[Signature]</u>				DATE CONSIDERED <u>Feb 7, 2005</u>			
Examiner: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							

Date: June 23, 2003

Notice of References Cited



Application/Control No.

10/600,352

Applicant(s)/Patent Under
Reexamination
ANAZAWA ET AL

Examiner

Steven H VerSleeg

Art Unit

1753

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	8-48510	02-1996	Japan	Mieno Satoru	C01B 31/02
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Yokomichi et al., "Effects of high magnetic field on the morphology of carbon nanotubes and selective synthesis of fullerenes", 29 March 1999, Applied Physics Letters, Vol. 74, No. 13, pg. 1827-1829
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



UNITED STATES PATENT AND TRADEMARK OFFICE

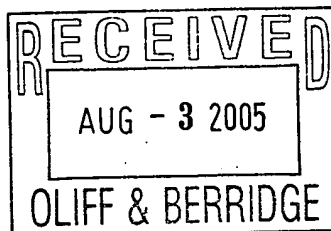


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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,352	06/23/2003	Kazunori Anazawa	116316	7092

25944 7590 08/02/2005

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320



EXAMINER

VERSTEEG, STEVEN H

ART UNIT PAPER NUMBER

1753

DATE MAILED: 08/02/2005

**FINAL REJECTION/
NOTICE OF APPEAL**

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED
By FMP on 8/3 2005
and
By Jmm on 8/3 2005
Oliff & Berridge

DOCKETED
By FMP on 8/3 2005
and
By Jmm on 8/3 2005
Oliff & Berridge

Office Action Summary

Application No.

10/600,352

Applicant(s)

ANAZAWA ET AL.

Examiner

Steven H. VerSteeg

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-33 is/are allowed.
- 6) ☒ Claim(s) 1 and 5-13 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 14-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 5-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 7-15 of copending Application No. 10/656,267. Although the conflicting claims are not identical, they are not patentably distinct from each other because the conflicting claims are fully claimed in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claim 1 of the instant application differs from claim 2 of the copending application in that claim 2 additionally requires a thermal shield d wall between the magnets and the plasma generation area. However, the thermal shield wall has a cooling unit. The cooling unit, because it is next to the magnets, would obviously cool the magnets. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of the

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compending application to utilize the cooling unit of the thermal shield wall as a magnet cooling unit because it is next to the magnets.

4. Claims 7-15 of the compending application contain all of the limitations of claims 5-13 of the instant application respectively. The claims wording is essentially identical and thus, no further discussion is necessary.

Response to Amendment

5. The objection to the specification presented in the office action mailed May 2, 2005 is withdrawn in light of the amendment.

6. The objection to the drawings presented in the office action mailed May 2, 2005 is withdrawn in light of the amendment.

7. The claim objection to claim 8 presented in the office action mailed May 2, 2005 is withdrawn in light of the amendment. The objection to claim 14 is withdrawn and should not have been made in the first place.

8. The 112-second paragraph rejection of claim 15 presented in the office action mailed May 2, 2005 is withdrawn in light of the amendment.

9. The provisional double patenting rejection of claims 1 and 5-13 over claims 2 and 7-15 of compending application 10/656,267 presented in the office action mailed May 2, 2005 stands.

Allowable Subject Matter

10. Claims 17-33 are allowed.

11. Claims 2-4 and 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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12. Claims 1 and 5-13 would be allowable if a terminal disclaimer is filed to overcome the double patenting rejection presented above.

Response to Arguments

13. Applicant's arguments filed July 11, 2005 have been fully considered but they are not persuasive.

14. Applicant has argued that because the provisional double patenting rejection is the only rejection in the application, the rejection should be withdrawn and the application allowed to issue. I disagree. The particular section of the MPEP to which Applicant refers, MPEP § 804I(B), does not specifically address the instant situation. Here we have the instant application with a provisional double patent rejection as the only rejection. The other application has no rejections and is about to issue. Thus, the specific passage referred to by Applicant does not apply because it is directed to the situation where a rejection is present in both applications.

15. For the instant situation, the next passage is more applicable which states, "If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent."

16. Here, one application has been allowed and will issue soon. Thus, a provisional double patenting rejection must be maintained in the instant application and will become a double patenting rejection when the other application issues as a patent.

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General Information

For general status inquiries on applications not having received a first action on the merits, please contact the Technology Center 1700 receptionist at (571) 272-1700.

For inquiries involving Recovery of lost papers & cases, sending out missing papers, resetting shortened statutory periods, or for restarting the shortened statutory period for response, please contact Denis Boyd at (571) 272-0992.

For general inquiries such as fees, hours of operation, and employee location, please contact the Technology Center 1700 receptionist at (571) 272-1300.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven H. VerSteeg whose telephone number is (571) 272-1348. The examiner can normally be reached on Mon - Thurs (6:30 AM - 5:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X. Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven H VerSteeg
Primary Examiner
Art Unit 1753

shv
July 28, 2005



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Name of Applicant: Kazunori ANAZAWA et al.

Serial No.: 10/600,352

Atty. File No.: 116316

Title (New Cases):

Sender's Initials: JAO:YSC/mdw

244/3

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